



Response under 37 CFR 1.116
-EXPEDITED PROCEDURE-

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lev Korenevsky
Application #: 10/037,548

Examiner: Shay L Balsis
Art Unit: 1744

Honorable Commissioner for Patents

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Sir,

This Amendment and Response is submitted in response to the Examiner's Office
Advisory Action dated 07/12/2004.

Introductory Comments

According to the Advisory Action 'the added <after the Final Action> limitation to claim 1...requires further considerations...<and>...raises new issues'. However, this wording was added to present my claim in a better form and, in particular, to make it clear why my invention is not anticipated by Thackara (USPN 2766473). I don't think that it adds anything new to the original claim.

Indeed, my original claim had the following wording:

'said bearing portion and said outer portion further comprising mating connection means having characteristics that ensure fast and tight trapping of the core and that prevent weakening of the sleeve squeezing while painting.'

The claim was rejected by the examiner who, in particular, stated that my invention was anticipated by Thackara (USPN 2766473). In my first response to this statement I explained that in Thackara's claim two corresponding elements are independently mounted on the shaft (and located at least several inches apart). Since this anticipation was repeatedly mentioned by the examiner in two answers, I attributed this to poor readability of my claim and decided to add some redundancy making the difference between my claim and Thackara's claim more clear.

The new version had the following wording:

'said bearing portion and said outer portion further comprising mating connection means and, for painting, directly and firmly connected using these mating connection means having characteristics that ensure fast and tight trapping of the core and that prevent weakening of the sleeve squeezing while painting.'

I made this changes to the original claim after discussing my intentions with the examiner and, unfortunately, was not advised that such wording would 'raise new issues'.

'Firmly' was added to emphasize 'tight trapping' and is completely redundant. 'Directly' is explaining the nature of any 'mating connection' that is important to prove that Thackara's claim does not anticipate my Claim 1. There is no needed in 'directly' when the term 'mating connection' is clear to the reader. I have researched your Database and found that since 1976 'mating connection' was used in 249 claims (USPN 6733313, 6722922, 6511102, and others). This is an established technical term that always implies

direct connection of two elements (usually, male and female from the perspective of the connection).

To comply with your requirements I am removing the redundant wording (added after the Final Action) that requires further consideration and is raising new issues, but had the only purpose to improve the language of the claim. At the same time, I acknowledge that phrasing of the original claim could be improved. According to 37 C.F.R. 1.116 (a) I can propose 'amendments presenting rejected claims in better form.' After researching a number of claims that use 'mating connection' in their language (USPN 5928021 is as a good example of clear wording), I prepared a new amendment that would improve readability and should not raise any new issues.

The form of the amendment is also fixed to list all not amended claims according to the explanations provided in your response.

Find attached Notice of Appeal and two checks to cover extension fees (\$55.00) and filing a notice of appeal (\$160.00).